

Appl. No.: 10/646,239
Attorney Docket: 2002B117/2
Amdt. dated April 5, 2006
Reply to Final OA of January 5, 2006

REMARKS/ARGUMENTS

This reply is intended as a full and complete response to the Final Office Action dated January 5, 2006. Claims 56-83 are pending in the application and stand rejected. Entry of the foregoing amendment and reconsideration of the claims is respectfully requested.

Claim 73 is objected to. Applicant has amended the claim to obviate the objection. Withdrawal of the objection is respectfully requested.

Claims 74-80 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Lue et al. (US 6,255,426) hereafter "Lue." The Examiner states that "because the film of Lue et al. has the exact same composition and is made by the same process, the film inherently has the same natural draw ratio and tensile stress values at the same elongation values, because if the composition is physically the same it must have the same properties."

Applicant respectfully traverses the rejection on grounds that Lue does not teach, show, or suggest the claimed invention. In particular, Lue does not teach, show, or suggest a multilayer film having a natural draw ratio of at least 250%, a tensile stress at the natural draw ratio of at least 22 MPa, and a tensile stress at second yield of at least 12 MPa, as measured according to ASTM D-882/97, as recited in every claim. For at least this reason, withdrawal of the rejection and allowance of the claims is respectfully requested.

Furthermore, Applicant respectfully traverses the rejection on grounds that Examiner's reason for rejection is erroneous. There is no basis to conclude that the "the film of Lue et al. has the exact same composition and is made by the same process." Claims 74-80 are directed to a multi-layer film. The composition of one layer in a multi-layer film does not reveal or determine the composition of the layered film. Lue discloses an ethylene copolymer as noted by the Examiner and Lue discloses a film that can comprise at least one layer of that ethylene copolymer. However, despite any similarities of one composition in a single layer of a multilayer film, if such similarities are true as asserted by the Examiner, nowhere does Lue disclose or suggest a multilayer film having a natural draw ratio of at least 250%, a tensile stress at the natural draw ratio of at least 22 MPa, and a tensile stress at second yield of at least 12 MPa as measured according to ASTM D-882/97, as recited in every claim. Therefore, withdrawal of the rejection and allowance of the claims is respectfully requested.

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Moreover, the fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish inherency of that result or characteristic. In re Rijckaert, 9 F.3d 1531, 1534, 28 U.S.P.Q.2d 1955, 1957 (Fed. Cir. 1993). Mere possibilities or even probabilities are not enough to establish inherency. See Continental Can Co. v. Monsanto Co., 948 F.2d 1264, 20 U.S.P.Q.2d 1746 (Fed. Cir. 1991). As stated above, Lue does not teach, show, or suggest a multilayer film having a natural draw ratio of at least 250%, a tensile stress at the natural draw ratio of at least 22 MPa, and a tensile stress at second yield of at least 12 MPa as measured according to ASTM D-882/97, as recited in every claim. Therefore, withdrawal of the rejection and allowance of the claims is respectfully requested.

Claims 74-80 also stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Lue in view of Wong et al. (US 6,358,457) hereafter "Wong." Here, the Examiner admits that Lue fails to teach a film having a particular natural draw ratio, and tensile stress at separate elongation values. Yet, the Examiner asserts that "Wong et al. teach that the natural stretch ratio is determined by factors such as the polymer composition, morphology caused by the process of forming the film." The Examiner, therefore, concludes that "since the film [of Lue] is formed by the same composition and made by the same process," the film "would obviously have a natural draw ratio... of at least 300%, a tensile stress at the natural draw ratio of at least 26 MPa, a tensile stress at second yield of at least 14 MPa, a tensile stress at first yield of at least 9 MPa, and... a yield plateau with a linear portion having a slope of at least 0.020 MPa per % elongation, as taught by Wong et al."

Applicant respectfully traverses the rejection on grounds that a combination of the references does not teach, show, or suggest the claimed invention. Lue has been discussed and distinguished above. Wong does not teach, show, or suggest a multilayer film having a natural draw ratio of at least 250%, a tensile stress at the natural draw ratio of at least 22 MPa, and a tensile stress at second yield of at least 12 MPa as measured according to ASTM D-882/97, as recited in every claim. Therefore, a combination of Lue and Wong does not teach or suggest the claimed invention. Withdrawal of the rejection and allowance of the claims is respectfully requested.

Further, Applicant respectfully traverses the rejection on grounds that the Examiner has not established a *prima facie* case of obviousness. To establish *prima facie* obviousness of a

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claimed invention, all claim limitations must be taught or suggested by the prior art. See In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). Further, the teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art, not in the Applicants' disclosure. See M.P.E.P. § 2143, citing In re Vaeck, 947 F.2d 488 (Fed. Cir. 1991). Still further, the Examiner must *particularly* identify any suggestion, teaching or motivation from *within* the references to combine the references (emphasis added). See In re Dembiczak, 50 USPQ2d 1614 (Fed. Cir. 1999). The mere recitation of a combination of references does not amount to particularly identifying a suggestion, teaching, or a motivation to combine the references.

Nowhere has the Examiner provided a suggestion, teaching, or motivation from *within* the references to combine their teachings to arrive at the claimed invention. Insofar as the record shows, if it is true that a multilayer film can have a natural draw ratio of at least 250%, a tensile stress at the natural draw ratio of at least 22 MPa, and a tensile stress at second yield of at least 12 MPa, it has been gleaned from the Applicant's own specification. Such hindsight reasoning is improper and cannot provide the basis for a Section § 103 obviousness type rejection. Withdrawal of the rejection and allowance of the claims is respectfully requested.

It is believed that the Examiner has not assessed the claimed invention as a whole. In making the assessment of differences in an obviousness determination, Section § 103 specifically requires consideration of the claimed invention "as a whole." Inventions typically are new combinations of existing principles or features. Envtl. Designs, Ltd. v. Union Oil Co., 713 F.2d 693, 698 (Fed. Cir. 1983) (noting that "virtually all [inventions] are combinations of old elements."). The "as a whole" instruction in title 35 prevents evaluation of the invention part by part. Without this important requirement, an obviousness assessment might break an invention into its component parts (A + B + C), then find a prior art reference containing A, another containing B, and another containing C, and on that basis alone declare the invention obvious. This form of hindsight reasoning, using the invention as a roadmap to find its prior art components, would discount the value of combining various existing features or principles in a new way to achieve a new result - often the very definition of invention.

Section 103 precludes this hindsight discounting of the value of new combinations by requiring assessment of the invention as a whole. The Federal Circuit has provided further

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assurance of an "as a whole" assessment of the invention under Section § 103 by requiring a showing that an artisan of ordinary skill in the art at the time of invention, confronted by the same problems as the inventor and with no knowledge of the claimed invention, would select the various elements from the prior art and combine them in the claimed manner. In other words, the Examiner or court must show some suggestion or motivation, before the invention itself, to make the new combination. See In re Rouffet, 149 F.3d 1350, 1355- 56 (Fed. Cir. 1998).

It is also believed that the Examiner is asserting an "obvious to try" standard because the Examiner argues that it would have been obvious to modify the teaching of Lue by playing with "factors such as the polymer composition, morphology caused by the process of forming the film and the like, and temperature and rate of stretching" as mentioned in Wong at col. 7, ll. 4-8. The Examiner is kindly reminded that obviousness is tested by what combined teachings of prior art references would have suggested to those of ordinary skill in the art, not by whether particular combination of elements from such references might have been "obvious to try." In re Fine (CA FC) 5 USPQ2d 1596 (1/26/1988). An invention is merely "obvious to try" if the prior art gives either no indication of which parameters are critical or no direction as to which of many possible choices is likely to be successful. Merck & Co, Inc. v. Biocraft Laboratories Inc., 10 USPQ2d 1843 (Fed. Cir. 1989).

Here, Wong makes no mention of multilayer films where at least one layer comprises a polyethylene copolymer having a Compositional Distribution Breadth Index (CDBI) of at least 70%, a melt index $I_{2.16}$ of from 0.1 to 15 g/10 min., a density of from 0.910 to 0.940 g/cm³, a melt index ratio $I_{21.6}/I_{2.16}$ of from 30 to 80, and an Mw/Mn ratio of from 2.5 to 5.5. Wong also makes no mention of a multilayer film having a natural draw ratio of at least 250%, a tensile stress at the natural draw ratio of at least 22 MPa, and a tensile stress at second yield of at least 12 MPa., as recited in every claim. Further, Wong makes no mention of criticality or direction to provide a multilayer film having a combination of a large natural draw ratio, a large tensile stress at second yield and at the natural draw ratio, and a positive yield plateau slope large enough to absorb typical variations in film thickness uniformity without tiger striping. See specification at paragraph [0007]. Therefore, a combination of the teachings of Lue and Wong does not teach, show, or suggest the claimed invention. Withdrawal of the rejection and allowance of the claims is respectfully requested.

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Claims 56-73 and 81-83 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Lue alone or in combination with Wong in view of Takahashi et al. (EP 982 362) hereafter "Takahashi." The Examiner states that "Lue et al. alone or in combination with Wong et al. teach all of the limitations of claim 56 as shown above with regard to claim 74, except that the multilayer stretch film comprises a surface layer on either side of the polyethylene copolymer containing layer." The Examiner then asserts that "Takahashi et al. teach that it is well known that packaging films are formed from polyethylene copolymers as monolayer films or multilayer films." The Examiner, therefore, concludes that it would have been obvious "to form the film of Lue et al. having more than one layer, as a three-layered film with the polyethylene copolymer forming the intermediate layer, depending on the intended end result of the film, as taught by Takashasi et al.

Applicant respectfully traverses the rejection on the grounds presented above. Particularly, a combination of Lue and Wong is improper and does not teach, show or suggest the claimed invention. Takashahi does not remedy the deficiencies of Lue and Wong, and the Examiner has not provided any teaching or suggestion from within the references themselves to arrive at the claimed invention. More importantly, none of the references, alone or in combination teach, show, or suggest a multilayer film having a natural draw ratio of at least 250%, a tensile stress at the natural draw ratio of at least 22 MPa, and a tensile stress at second yield of at least 12 MPa as measured according to ASTM D-882/97, as recited in every claim. Therefore, a combination of all three references does not teach, show, or suggest the claimed invention, and withdrawal of the rejection and allowance of the claims is respectfully requested.

Furthermore, Takashahi makes no reference or suggestion to place the copolymer of the claimed invention as the core layer recited in base claim 56 and those dependent therefrom. Takashahi merely teaches that multilayer films are possible. As such, Applicant submits that the Examiner has underestimated the problem solved by the Applicant and over-simplified the Applicant's claimed invention.

As stated in the specification, the claimed multilayer film provides a combination of a large natural draw ratio, a large tensile stress at second yield and at the natural draw ratio, and a positive yield plateau slope large enough to absorb typical variations in film thickness uniformity without tiger striping. See specification at paragraph [0007]. Further, the specification states "It

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has been surprisingly found that films of the invention exhibit improved properties, such as applicability over a wide range of stretch ratios without suffering from local deformation leading to break, hole formation, tiger striping, or other defects. Films of embodiments of the invention also show higher holding force than conventional films of the same film thickness." Id. at paragraph [0096]. Therefore, absent a motivation or suggestion from within the references themselves to arrive at the claimed invention, a rejection based on § 103 obviousness is improper and should be withdrawn. Accordingly, withdrawal of the rejection and allowance of the claims is respectfully requested.

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CONCLUSION

Having addressed all issues set out in the office action, Applicant respectfully submits that the pending claims are now in condition for allowance. Applicant invites the Examiner to telephone the undersigned attorney if there are any issues outstanding which have not been addressed to the Examiner's satisfaction.

Respectfully submitted,

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Date

Amy C. Trexler
Amy C. Trexler
Attorney for Applicant
Registration No. 51,531

Post Office Address (to which correspondence is to be sent):
ExxonMobil Chemical Company
Law Technology
P.O. Box 2149
Baytown, Texas 77522-2149
Telephone No. (281) 834-5519
Facsimile No. (281) 834-2495